

II. Remarks

The Official Action of August 13, 2009 has been thoroughly studied. Accordingly, the following remarks are believed to be sufficient to place the application into condition for allowance.

STATUS OF CLAIMS

Claims 1-6, 8-10 and 15 are pending in this application.

GROUNDS OF REJECTION TO BE REVIEWED

Whether claims 1-6, 8-10 and 15 were properly rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Whether claims 1-6, 8-10 and 15 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,387,292 to Saito in view of U.S. Patent Application Publication No. 2003/0114547 to Hara et al.

ARGUMENT

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 1-6, 8-10 and 15 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Under this rejection the Examiner has taken the position that in claim 1, line 4 the recitation "nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol" is not described in the original specification.

The Examiner takes the position that the recitation of "nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol" is "new matter" in the application.

Applicants submit that the recitation of "nonionic surfactant comprising a condensation product of polyethylene oxide (n=10-90) and octyl phenol or nonyl phenol" is found in the Japanese text of international application PCT/JP2004/000459 that was filed on January 21, 2004 and published as WO 2004/067579 on August 12, 2004 and is therefore not new matter for at least the following reasons:

Reason 1:

MPEP 2163.07 provides, in part, that:

An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

In the present situation the typographical or clerical which resulted in the recitation of "a condensation product of polyethylene oxide (n=10-19)" on page 6 of applicants' specification is clearly not commensurate with the applicants' working examples. In Example 3 applicants' specification recites "polyethylene (n:30) mono(nonylphenyl) ether 2.5 parts by weight" and "polyethylene (n:50) mono(nonylphenyl) ether 8.6 parts by weight."

These examples clearly indicate that the range of n=10-19 is an error and not commensurate with other parts of applicants' specification

This error is "obvious" when applicants' specification is read by those skilled in the art.

Once one skilled in the art would recognize this "obvious" error, the only "appropriate correction" is that of "a condensation product of polyethylene oxide (n=10-90)" found in the Japanese text of applicants' original international PCT application.

Reason 2:

MPEP 2163.07 states, in part, that:

Where a foreign priority document under 3S U.S.C. 119 is of record in the U.S. application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending U.S. application.

In the present situation it is important to note that applicants are **not** relying upon their foreign priority document for the recitation of n=10-90.

Rather in the present situation applicants are relying upon International PCT application PCT/JP2004/000459 which is the actual application that is filed in the United States when the International PCT application is nationalized in the United States.

That is, the nationalized United States application Serial No. 10/541,330 does not claim "foreign" priority to the International PCT application under 35 U.S.C. §112, but rather domestic National stage priority under 3S U.S.C. §120.

Therefore the inability to rely upon the disclosure in a document to which "foreign" priority is claimed for correcting an error (as set forth in MPEP 2163.07) does not apply and the Examiner cannot exclusively look to applicants' foreign priority document for support for the disclosure that is found in the International application.

There is no provision which prevents applicants from relying upon the text of the International PCT application PCT/JP2004/000459 from which domestic National stage priority is claimed under 35 U.S.C. §120.

Reason 3:

As indicated on the "TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION
UNDER 35 U.S.C. 371" applicants filed "An English language translation of the International
Application as filed (35 U.S.C. 371(c)(2))"

Thus, applicants were prohibited from making any changes from the disclosure of the
International Application, when submitting an English language Translation of the International
Application.

Accordingly, applicants are entitled to rely upon the text of the International Application
to correct any translational, typographical or clearical errors in the translated application.

If any "new matter" issues should have been raised, the Examiner himself should have
questioned how the range of "(n=10-90)" ended up being translated to "(n=10-19)."

For any one and all of the above reasons, it is submitted that the amendment to change
"(n=10-19)" to --(n=10-90)-- in the specification and to further recite --(n=10-90)-- in
claim 1 does not involve any new matter.

Rather these amendments conform the application to the International PCT Application.
The Examiner keeps insisting that the recitation n=10-90 is not found in applicants'
Japanese priority document, e.g. JP 2003-018169.

The Examiner is not considering that applicants are relying the original Japanese of their
International application, e.g. PCT/JP2004/000459, which can include material that is not
included in applicants' Japanese priority document

Rejection Under 35 U.S.C. §103(a)

Claims 1-6,8-10 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,387,292 to Saito in view of U.S. Patent Application Publication No. 2003/0114547 to Hara et al.

The Examiner has relied upon Saito as disclosing:

....a process of preparing an anti-soil composition in the form of an aqueous dispersion comprising a fluoroalky group-containing monomer with a polymerizable monomer free of fluorine atoms, and polypropylene glycol having an average molecular weight of not more than 1,000. Saito (col. 2, line 12-13) disclose a C₁₂-fluoroalky group containing monomer. Saito (col. 3, line 10-20) disclose a list of polymerizable monomers that include cyclohexyl (meth)acrylate, benzyl (meth)acrylate, stearyl (meth)acrylate, acrylamide. The disclosed stearyl (meth) acrylate of Saito (col. 3, line 10-20) generically include stearyl acrylate in view of claim 2 of Saito, where a (meth)acrylate ester also includes an acrylate ester. Saito clearly indicate using a polymerization initiator (col. 4, line 67), and surfactants (col. 5, line 65 to col. 6, line 7). Saito (col. 4, example 1) disclose a formulation comprising at least 10 wt% of polyfluoroalkyl groups. Saito et al. (col. 6, line 8-12) describe the process of preparing an aqueous dispersion comprising water.

Regarding the claimed non-ionic surfactant, Saito (col. 5, line 65 to col. 6t line 3) clearly disclose the use of non-ionic surfactants based upon polyethylene glycol and octyl or nonyl phenol.

The Examiner has relied upon Hara et al. as disclosing:

...a process for preparing a dispersion of fluorine-containing polymer. Further, Hara et al. (page 2, 0036-0038) clearly teach the combination use of different types of surfactants, which includes cationic surfactants (page 2, 0037) and nonionic surfactants (page 2, 0038) as claimed.

In combining the teachings of Saito and Hara et al. the Examiner takes the position that:

...it would have been obvious....to incorporate the combination use of cationic surfactants and non-ionic surfactants as taught by Hara et al. into the Saito to obtain the invention of claims 1-6, 8-10, 15.

Applicants' independent claim 1 requires a nonionic surfactant.

The Examiner states that Saito teaches surfactants at column 5, line 65 to column 6, line 7.

The portion of Saito which the Examiner cites reads as follows:

In Example 1, 0.76 g of Emulgen 950 (trademark of a product commercially available from Kao Corp., Japan) and 0.84 g of Emulgen 930 (trademark of a product commercially available from Kao Corp., Japan), both being non-ionic surfactants, 30.15 g of acetone and 121.67 g of water were used in place of 130 g of polypropylene glycol. 1.2 g of azobisisobutyroamidine.dihydrochloride was used as a polymerization initiator in place of 2.5 g of azobisisobutyronitrile. Polymerization reaction product was gelled.

Because the polymerization reaction produced a gelled product, Saito teaches that the non-ionic surfactant had an adverse affect and therefore teaches against the use of non-ionic surfactants.

Thus, contrary to the Examiner's position, Saito teaches against the use of at least non-ionic surfactants, and therefore teaches against applicants' claimed invention

Applicants previously argued that Saito prepares the polymer before the emulsification step with water while applicants' claims involves adding water first.

In the paragraph bridging pages 6 and 7 of the Office Action the Examiner takes the position that the "the mixing order of the processing steps would not affect the outcome of obtaining an aqueous dispersion."

Saito does not teach a prior emulsification treatment before the polymerization reaction.

Rather the "aqueous dispersions" of Saito are produced after the polymerization reaction as disclosed in column 6, lines 8-15:

The anti-soil finishing agents and the solutions obtained in Examples 1 to 5 and Comparative Examples 1 and 2 were diluted with water, respectively, to adjust the calculated copolymer concentrations to 17.5 wt. %, thereby preparing aqueous dispersions. In case of Comparative Example 1, the copolymers were precipitated

upon formation of a discrete layer, whereas neither precipitation nor formation of such a discrete layer were observed in other cases

and in working Examples 1-5 of Saito.

In contrast to Saito, in the present invention water is added before the polymerization.

This is recited in applicants' independent claim 1 which recites in part:

...subjecting (meth)acrylate containing a polyfluoroalkyl group and a polymerizable monomer free of fluorine atoms to an emulsification treatment in the presence of water.

It is again noted that on page 7 of the Office Action the Examiner states:

In view of the 112 rejection set forth for the introduction of "new matter" into the claims, the instant rejection [under 35 U.S. C. 103(a)] is proper.

Thus, entry of the amendments to the abstract and claims (to recite n=10-90) will overcome the prior art rejection of the claims.

CONCLUSION

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a *prima facie* case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 23-1925 and please credit any excess fees to such deposit account.

Respectfully submitted,

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